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In re Application of :
Corey S. Goodman et al :
Serial No.: 08/971,172 : PETITION DECISION
Filed: November 14, 1997 :
Attorney Docket No.: B98-006-2 :

This is in response to applicants' request filed March 6, 2003 to rescind the Director's petition decision and Examiner's Answer, the petition decision having been mailed January 22, 2003. The request has been forwarded to the Technology Center Director by the Office of Petitions for consideration.

BACKGROUND

A review of the file history as set forth in the previous decision and not disputed in the present petition shows that a restriction requirement was mailed to applicants on September 14, 1998, to which a reply was made on September 18, 1998. A first rejection of the claims was made on March 5, 1999, and a reply thereto made on May 21, 1999 and July 29, 1999. A Final Office action was mailed by the examiner on October 14, 1999, to which a reply was made on November 15, 1999, followed by an interview on December 13, 1999. A new non-final Office action was mailed by a new examiner to applicants on January 21, 2000, to which a reply was made on February 16, 2000. A subsequent non-final Office action was mailed to applicants on May 10, 2000, with a reply being filed on September 7, 2000. A third non-final Office action was mailed to applicants on March 27, 2001, regarding which a petition was filed on June 17, 2001, and denied on July 9, 2001. A reply to the Office action was filed on July 17, 2001. A Final Office action was mailed to applicants on October 10, 2001, in response to which a petition was filed on December 14, 2001, and denied on May 1, 2002. A Notice of Appeal was filed on February 11, 2002, as well as an Amendment after Final Office action and a petition, both filed on January 30, 2002. The petition was denied on June 12, 2002, and an Advisory action mailed on June 17,

2002. Applicants' Appeal Brief was filed on July 2, 2002. The examiner mailed an Examiner's Answer to applicants on October 1, 2002. A Reply Brief and a petition to rescind the Examiner's Answer were filed on December 16, 2002. Since the mailing of the petition decision the Reply Brief has been considered by the examiner who entered it without further comment.

The present petition alleges that the previous petition decision is "factually and legally incorrect" and is "triply flawed". The petition refers to the previous petition and its presentation of improper prosecution by the Office with respect to application of a reference, specifically the date of availability of the reference. In the petition applicants contend that the date of availability has been changed by the examiner and thus the reference is new evidence (new rejection) which applicants have not had an opportunity to rebut.

DISCUSSION

Applicants' petition concerns specifically certain published sequences cited by applicants to the Office and cited by the examiner to applicants and their dates of public accessibility. The date of public accessibility determines whether the reference is applicable under 35 U.S.C. 102(a) and whether an affidavit under 37 CFR 1.131 may be used to defeat (cause withdrawal of) the reference and, hence, cause withdrawal of the rejection. The specific references in question are publications of gene sequences identified as O01632 and U88183. The alleged date of availability of O01632 is April 21, 1997, as stated by applicants. U88183 is stated to be equivalent to (or embedded in) O01632. U88183 is claimed by applicants to have a public availability date of April 21, 1997. However, the examiner determined that the U88183 sequence had an earlier date of public availability of February 14, 1997. Moreover a more recent e-mail inquiry by the examiner gives a first date of public availability of February 7, 1997. Either date is prior to the applicants' alleged date of availability of O01632.

A thorough review of the file has been undertaken to determine in which paper the above sequences and their dates of public availability are first mentioned, with the results as follows:

Paper No. 16. (Office action dated 01/21/00) SPTREMBL Accession No. O01632, page 4 of the action and PTO-892 attachment. Cited as part of rejection under 35 U.S.C. 102(b) as anticipated by Wilson et al as evidenced by Sambrook et al. (Wilson et al is the author of the article describing O01632.) Copy of December 21, 1999, printout of GenBank search provided to applicants (see Form-892) indicating public availability of 1 July 1997. Document also references U88183.

Paper No. 17. (Response by applicants dated 02/16/00) Includes a copy of U88183 that contains a date of 21 Apr 1997, but no definition of what the date means. The printout also contains four references, each having a different date (one being unpublished). The last two references are indicated as being direct submissions having dates of 03-Feb-1997 and 21-Apr-1997, respectively. The submission is also accompanied by two affidavits, one under 37 CFR 1.132 with respect to a particular term of usage and one under 37 CFR 1.131 seeking to establish a date of invention prior to April 21, 1997.

Paper No. 19. (Office action dated 05/10/00) O01632 and U88183 are indicated as equivalents on page 4 (rejection over Wilson et al) with the affidavit under 37 CFR 1.131 being found insufficient to establish a date of invention prior to April 21, 1997, because certain required statements are lacking. The rejection of record is maintained.

Paper No. 21. (Response dated 09/07/00) Provides second affidavit under 37 CFR 1.131 to antedate the reference. The affidavit claims determination of the sequence prior to 21 April 1997. Arguments on page 13 are related thereto.

Paper No. 24. (Office action dated 03/27/01) Non-final Office action sets forth a specific rejection of claims 88-90 under 35 U.S.C. 102(a) over Sptrembl (in other places cited as SPTREMBL) sequence O01632 and GenBank Accession No. U88183. Affidavit under 37 CFR 1.131 is found non-persuasive in view of relevant release date of U88183 being 02/14/97 as created by GenBank. (It appears that a copy of this printout was supplied to applicants.)

Paper No. 27. (Response dated 07/17/01) Pages 6-7 specifically claim that O01632 and U88183 were released on April 21, 1997, and not earlier. Applicants specifically note reference 3 of the printout as having a submitted date of 02-13-97 (sic 02-03-97) as the date closest to the examiner's purported availability date of 02-14-97. Applicants discount this date by continuing to allege that the sequence of O01632, which includes U88183, was not available until 21 April 1997.

Paper No. 29. (Final Office action dated 10/10/01) Rejection is maintained with arguments on pages 6-7 clearly stating that the "created date" of a GenEmbl (sic - GenBank Embl) sequence is the public availability date (emphasis added) based on information obtained from the USPTO library and GenBank Embl. The printed record of U88183 shows a "created" date of 02-14-97 (the word "created" being in parenthesis). The website where the information in the printout was obtained is also set forth in the Office action. A Form PTO-892 accompanied the action and sets forth the citation of U88183 and its date. The examiner further relies on applicants' arguments "that O01632 contains the same sequence as . . . U88183". U88183 was created on 02-14-97 and became publicly available as of that date. The examiner then concludes that the public availability date of Accession No U88183 is what is at issue. (Note that this is a repetition of the rejection of the previous Office action and uses the same date of public availability.)

Paper No. 33. (Response dated 01/30/02) Amendment after Final rejection argues at pages 3-4 that the creation date is not the public availability date and provides a Sample GenBank record and explanation of all of the fields for a GenBank flat file format. The file format differs from the format supplied by the examiner to applicants. Applicants' note that the LOCUS line (first line) contains a date at the end, which is defined in the explanation as the last modification date, not necessarily the public release date. However, the record supplied by the examiner contains a different format and specifically contains a date indicated as the release date (14 FEB-1997) as well as a "last updated "

date of 04-MAR-2000, noted as version 3. Applicants filed a Notice of Appeal on February 11, 2002.

Paper No. 36. (Advisory action mailed 06/17/02) Examiner entered the amendment after final rejection without presenting any arguments or rebuttal to applicants' positions.

Paper No. 37 (Appeal Brief filed 7/02/02) Pages 6-8 repeat previous arguments.

Paper No. 38. (Examiner's Answer mailed 10/01/02) Rejection set forth in the Final Office action is repeated with appropriate explanations on pages 6-7. (Note - the date of availability is misstated on page 6, lines 4-5 as 7-1-97, but elsewhere on pages 6-7 is correctly stated as 2-14-97.) Arguments and rebuttal to applicants' position are set forth beginning at page 11. The examiner notes that applicants allege (in response to the Final Office action) that the "created date" is not the public availability date, but comments that applicants have provided no evidence showing that the "created date" is not the public availability date for this sequence. The examiner thus maintains that the earlier filed affidavits under 37 CFR 1.131 (which only claim invention prior to 21 April 1997) are moot. The examiner further notes applicants' arguments with respect to the LOCUS date, but finds no evidence provided by applicant that the public availability date is other than that on the record itself. However, the examiner, to further support the rejection of record (and rebut applicants' arguments) performed an inquiry of the database, as indicated in the GenBank Sample Record explanations, with respect to U88183 and included within the body of the Examiner's answer the text of the e-mail response. The response actually indicates a first public availability date of 02/07/97 for U88183. A copy of the actual e-mail is found in the file. The examiner, however, continued to rely on the 14 February, 1997, date as the date of public availability for the reference.

Paper No. 40. (Reply Brief filed 12/16/02) Pages 4-6 repeat previous arguments about improper rejection.

Paper No. 41. (Petition to rescind Answer filed 12/16/02) Petition alleging that the examiner introduced new evidence into the record that violates the rules regarding examiner's answers.

Paper No. 42. (Petition Decision mailed 01/23/03) Decision upholding position of the examiner and in regard to which this petition was filed.

The petition points out what applicants believe to be flaws in the decision. The first alleged flaw is that "the decision 'Orwelleanly' argues that the new evidence is not new evidence, but merely source material to confirm further facts already of record". A review of the record above shows that the examiner has brought forth no new rejection based on new evidence since the non-final Office action of 03/27/01 in which a specific rejection of claims 88-90 under 35 U.S.C. 102(a) over Sptrembl sequence O01632 and GenBank Accession No. U88183 was set forth. The examiner therein alleged a date of public availability of 14 February 1997, based on the printout of

the GenBank data for U88183. Applicants have challenged that date as being improper, incorrect and/or unbelievable. Applicants have presented nothing but argument in making such challenge. One of the arguments presented after the Final Office action was that the "created date" was not the public availability date. In rebuttal to that argument the examiner inquired directly to the database asking for the date of first public availability. Applicants could have made the same inquiry. The inquiry resulted in GenBank identifying 7 February 1997, as the date of first public availability for U88183 - one week earlier than the "created" date on the printout. It is also noted that U88183 is shown on the O01632 printout as having been submitted on 3 February 1997, thus establishing that the sequence was submitted earlier than published or made available to the public. Such evidence rebuts fully applicants' claim that the sequence was not available until after 21 April 1997. It appears from the record that U88183 is a portion of O01632 and was available by itself prior to the availability of O01632. Such is an entirely plausible scenario.

Applicants are directed to M.P.E.P. 707.05(e) regarding data used in citing references, and especially to electronic documents (such as sequence listings) that can be retrieved from an online database. M.P.E.P. 2128 gives further instruction on electronic publications as prior art and specifically states as follows (emphasis added below):

A REFERENCE IS A "PRINTED PUBLICATION" IF IT IS ACCESSIBLE TO THE PUBLIC

A reference is proven to be a "printed publication" "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." In re Wyer, 655 F.2d 221, 210 USPQ 790 (CCPA 1981) (quoting I.C.E. Corp. v. Armco Steel Corp., 250 F. Supp. 738, 743, 148 USPQ 537, 540 (SDNY 1966)) ("We agree that 'printed publication' should be approached as a unitary concept. The traditional dichotomy between 'printed' and 'publication' is no longer valid. Given the state of technology in document duplication, data storage, and data retrieval systems, the probability of dissemination' of an item very often has little to do with whether or not it is 'printed' in the sense of that word when it was introduced into the patent statutes in 1836. In any event, interpretation of the words 'printed' and 'publication' to mean 'probability of dissemination' and 'public accessibility' respectively, now seems to render their use in the phrase 'printed publication' somewhat redundant.") In re Wyer, 655 F.2d at 226, 210 USPQ at 794.

See also *Carella v. Starlight Archery*, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986) (*Starlight Archery* argued that *Carella's* patent claims to an archery sight were anticipated under 35 U.S.C. 102(a) by an advertisement in a Wisconsin Bow Hunter Association (WBHA) magazine and a WBHA mailer prepared prior to *Carella's* filing date. However, there was no evidence as to when the mailer was received by any of the addressees. Plus, the magazine had not been mailed until 10 days after *Carella's* filing date. The court held that since there was no proof that either the advertisement or mailer was accessible to any member of the public before the filing date there could be no rejection under 35 U.S.C. 102(a).).

ELECTRONIC PUBLICATIONS AS PRIOR ART

Status as a "Printed Publication"

An electronic publication, including an on-line database or Internet publication, is considered to be a "printed publication" within the meaning of 35 U.S.C. 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates. See In re Wyer, 655 F.2d 221, 227, 210 USPQ 790, 795 (CCPA 1981) ("Accordingly, whether information is printed, handwritten, or on microfilm or a magnetic disc or tape, etc., the one who wishes to characterize the information, in whatever form it may be, as a printed publication' * * * should produce sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and

thus most likely to avail themselves of its contents.’ ” (citations omitted).). See also *Amazon.com v. Barnesandnoble.com*, 73 F. Supp. 2d 1228, 53 USPQ2d 1115, 1119 (W.D. Wash. 1999) (Pages from a website were relied on by defendants as an anticipatory reference (to no avail), however status of the reference as prior art was not challenged.); *In re Epstein*, 32 F.3d 1559, 31 USPQ2d 1817 (Fed. Cir. 1994) (Database printouts of abstracts which were not themselves prior art publications were properly relied as providing evidence that the software products referenced therein were “first installed” or “released” more than one year prior to applicant’s filing date.).

The Office policy requiring recordation of the field of search and search results (see MPEP § 719.05) weighs in favor of finding that Internet and on-line database references cited by the examiner are “accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.” *Wyer*, 655 F.2d at 221, 210 USPQ at 790. Office copies of an electronic document must be retained if the same document may not be available for retrieval in the future. This is especially important for sources such as the Internet and online databases.

Date of Availability

Prior art disclosures on the Internet or on an on-line database are considered to be publicly available as of the date the item was publicly posted. If the publication does not include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. 102(a) or (b), although it may be relied upon to provide evidence regarding the state of the art. Examiners may ask the Scientific and Technical Information Center to find the earliest date of publication. See MPEP § 901.06(a), paragraph IV. G.

Extent of Teachings Relied Upon

An electronic publication, like any publication, may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See MPEP § 2121.01 and § 2123.

From the above it is clear that the examiner has done all that was required in citing the U88183 reference and ascribing to it a specific date of (first) public availability based on information on the printout. When challenged, the examiner, as was required to answer applicants’ arguments, provided additional proof of public availability by contacting the Scientific and Technical Information Center and requesting that they provide the earliest date of availability of the sequence. This was then provided by e-mail from GenBank which confirmed that the date relied on by the examiner, 14 February 1997, was a valid date as it was subsequent to the 7 February 1997, date provided by GenBank in the e-mail communication as the date of first public accessibility. Such proof did not change the reference or the date relied on by the examiner, but merely confirmed it. (It is no different that a magazine having a publication date of 14 February 1997, but being available in grocery stores, etc., on 7 February 1997.) The examiner continues to rely on the date of first public availability set forth on the printout (14 February 1997). Applicants have had ample opportunity to provide evidence of error in the date or to provide evidence of invention prior to the date alleged by the examiner, but have chosen not to do so, other than to argue that the date is incorrect. Neither the examiner’s actions nor the petition decision supporting them is flawed or in error.

Applicants’ second alleged flaw is that the record of publication dates on which the examiner relies is inconsistent and thus unreviewable. Applicants allege that the document allegedly created in February, 1997, could not reference dates in March, 2000. Applicants misconstrue the information on the printout which states a “created date” of 02-14-1997 and a last updated date of 04-MAR-2000. The “last updated” date is not a creation date, as applicants would have the examiner believe, but merely the date on which some access or updating of data associated with

the sequence was made (such as an additional place where it was discovered, e.g. - mouse DNA as well as human DNA). There are many databases that include or can produce information on the number of times a particular record is accessed and when it was modified. As noted above, the record is eminently easily reviewable as the examiner has never relied on a date other than 14 February 1997, and continues to rely only on that date for purposes of the rejection.

Applicants' third alleged flaw is described as "reckless partisanship" by misstating dates of papers and "dancing around" the difference in dates of public availability. It is agreed that the date of the non-Final Office action was inadvertently misstated as July 9, 2001, in the previous petition decision. The correct date is March 27, 2001. The examiner, however, in the Answer did not "dance around" the discrepancy in dates, but clearly stated that either date is prior to the date of invention alleged by applicants. The examiner continued to rely only on the February 14, 1997, date as the date of public availability of the sequence and has not relied on the February 7, 1997, date except to substantiate that the sequence was available publicly by February 14, 1997. Although either of these dates is prior to April 21, 1997, the examiner has merely stated that applicants have failed to provide any evidence of invention prior to April 21, 1997. There is no equivocation on the examiner's part in the Examiner's Answer, as alleged by applicants.

DECISION

The renewed petition is **DENIED**. The previous petition remains unmodified except as clarified above.

The application will be forwarded to the Board of Patent Appeals and Interferences for action thereon.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703) 308-3824 or by facsimile transmission at (703) 305-7230.

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